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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/029,172

12/28/2001

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EXAMINER

HOSSAIN, FARZANA E

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/029,172	<b>Applicant(s)</b> WATSON ET AL.	
	<b>Examiner</b> FARZANA E. HOSSAIN	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 06 May 2008.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-6 and 18-20 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-6 and 18-20 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to communications filed 05/06/2008. Claims 1, 6 and 18 are amended. Claims 2-5, 19 and 20 have been previously presented. Claims 7-17 are cancelled.

### ***Response to Arguments***

2. Regarding Claims 1 and 18 (and dependent claims), the applicant argues the previous 112, 1<sup>st</sup> paragraph rejection due to the amendment are not persuasive.

In response to the argument, the examiner respectfully disagrees as the new amendment resulted in a new 112, 1st paragraph written description rejection and a previous limitation was not addressed in Claim 1.

Claim 6 is no longer rejected under 112, 1<sup>st</sup> paragraph. The amendment addressed the necessary items.

3. Applicant's arguments with respect to claims 1-6 and 18-20 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Claims 1 and 18, the applicant argues that the combination does not teach the processor receiving an instruction when there is a difference between the capacity of the disk drives and authorized storage for the STB defined in a database,

the difference indicating unauthorized modifications to the STB, the instruction causing the processor to disable operation of the set top box (Page 6).

In response to the argument, Feigen discloses a database storing configuration information of numerous remote units (Column 3, lines 8-10, Column 7, lines 15-23) and sends hash function to the STB (Figure 3, 52). Feigen discloses a method of initiating communications between a STB or remote unit (Figure 1, 14, Column 3, lines 18-20) and a service provider (Figure 2, Column 6, lines 53-67, Column 7, lines 1-6); Feigen discloses the first port of the remote communication unit or STB sending resource information associated with the STB describing memory space and size (Figure 2, Column 6, lines 53-67, Column 7, lines 1-6). Feigen disclose a database storing configuration information of numerous remote units (Column 3, lines 8-10, Column 7, lines 15-23) and send hash function to the STB (Figure 3, 52) and a difference is determined between the capacity of the disk drive and authorized storage for the STB or remote unit defined in a database (Column 7, lines 15-23), the difference indicating unauthorized modifications to the STB (Column 7, lines 28-42). Gold discloses describing at least two disk drives and capacity of each disk drive (Column 3, lines 64-67, Column 4, lines 1-3, Column 5, lines 10-25, 60-67, Column 6, lines 1-10, 53-67, Column 7, lines 1-19). Bru discloses the port receiving an operating instruction (Column 4, lines 5-31). Bru disclose that the apparatus with storage can include hard disk drive or solid state memory (Column 1, lines 7-10, Column 2, lines 54-65); and wherein the processor receives and executes the operating instruction when there is a difference between the capacity of the disk drive and the authorized storage for the STB the

difference indicating unauthorized modifications to the STB (Column 4, lines 5-44). Bru discloses the operating instruction causes the processor to limit the capacity of the disk drive (Column 4, lines 5-14). Medvinsky discloses the processor receiving an instruction based on unauthorized modifications and the instruction causing the processor to disable operation of the STB (Page 5, paragraphs 0056, 0058, Page 4, paragraphs 0047-0049). See new rejections.

Furthermore, in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct 1727, No. 04-1350, slip. op. at 12 (2007), the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: Claim 1 recites “a first port ....a database....a database.” The Office assumes the second “a database” to -the database---. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-6, 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 discloses a first port coupling a processor to a database. The specification discloses that the service provider receives the resource information from the STB and compares the resource information with the configuration information from the database to detect unauthorized modifications (Pages 11, paragraphs 0041-Page 12, paragraph 0044). The applicant's specification discloses the service provider has access to the database storing configuration information (Pages 11, paragraphs 0041-Page 12, paragraph 0044). There is no information of whether the database is remote from the service provider. Regardless of the connection between the service provider and database, the STB does not have access to the database as there is no disclosure in the applicant's specification. The STB may be connected to the database in some form based on the connection to the service provider but there is no direct connection to the database with the processor.

Claims 1 and 18 (and dependent claims) also disclose an instruction causing the processor to disable operation of the set top box. The specification specifically discloses disabling use of unauthorized resources (Page 13, paragraph 0049); there is

no mention of operating instructions to disable operation of the set top box simple configurations (Pages 13-14, paragraphs 0049-0055).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levin et al (US 6,654,546 and hereafter referred to as "Levin") in view of Feigen et al (US 6,925,566 and hereafter referred to as "Feigen"), Gold (US 6,662,284), Coss et al (US 6,170,012 and hereafter referred to as "Coss"), Bruynsteen et al (US 6,658,663 and hereafter referred to as "Bru") and Medvinsky (US 2004/0194124).

Regarding Claims 1 and 18, Levin discloses a set top box, and a method comprising: a first port coupling to a processor to a communication network (Figure 1, 113, 104, 115). Microsoft's Computer Dictionary (4<sup>th</sup> edition) defines port as an interface through which data is transferred between a computer and other device, a network or a direct connection to another computer. Levin discloses the processor controlling and processing resource information associated with the STB or playback device describing disk drive and other mass storage devices and a capacity of the disk drive (Figure 1,

112, Column 2, lines 37-41), the first port receiving an operating instruction to access an additional portion of a disk drive (Column 3, lines 1-25, 39-64, Figure 2, Figure 3); wherein the processor executes the operating instruction to repartition the capacity of the disk drive (Column 3, lines 1-6, 39-64). Levin disclose a second port coupling the processor to a second communications network or the processor is connected to the network supplying video information for recording via the second service provider, which is executed by the processor or initiating communication between the STB and second service provider (Figure 1, 104, 113, Column 2, lines 18-31).

Levin is silent on the first port coupling the processor to a database and sending resource information associated with the set top box describing at least two disk drives and capacity of storage and initiating communication between a STB and a service provider, the operation instruction that permits the processor to access an additional portion of at the at least two disk drives, a firewall determining when a source is authorized to communicate with the STB and determining when a communications protocol is authorized, the firewall thus protecting the STB from unauthorized access; the processor receiving an instruction when there is a difference between the capacity of the disk drives and authorized storage for the STB defined in a database, the difference indicating unauthorized modifications to the STB, the instruction causing the processor to disable operation of the STB.

In analogous art, Feigen discloses a set top box (STB) or remote unit, comprising: a first port (Figure 1, 14) coupled to the first communications network and a database or storage location (Column 7, lines 15-23). Microsoft's Computer Dictionary



(4<sup>th</sup> edition) defines port as an interface through which data is transferred between a computer and other device, a network or a direct connection to another computer. It is necessarily included that the STB includes a processor as the STB performs processes and sends resource information (Figure 2, Column 6, lines 53-67, Column 7, lines 1-6, 26-43). It is inherent that a database is a storage location to store a large amount of data for convenient access to perform functions. Feigen disclose a database storing configuration information of numerous remote units (Column 3, lines 8-10, Column 7, lines 15-23) and send hash function to the STB (Figure 3, 52) and a difference is determined between the capacity of the disk drive and authorized storage for the STB or remote unit defined in a database (Column 7, lines 15-23), the difference indicating unauthorized modifications to the STB (Column 7, lines 28-42). Feigen discloses a method of initiating communications between a STB or remote unit (Figure 1, 14, Column 3, lines 18-20) and a service provider (Figure 2, Column 6, lines 53-67, Column 7, lines 1-6). Feigen discloses the first port of the remote communication unit or STB sending resource information associated with the STB describing memory space and size (Figure 2, Column 6, lines 53-67, Column 7, lines 1-6). Microsoft's Computer Dictionary (4<sup>th</sup> edition) defines memory as a device where information can be stored and retrieved and in the most general sense memory can refer to disk drives. In analogous art, Gold discloses describing at least two disk drives and capacity of each disk drive (Column 3, lines 64-67, Column 4, lines 1-3, Column 5, lines 10-25, 60-67, Column 6, lines 1-10, 53-67, Column 7, lines 1-19)). Coss discloses a user site connected to the Internet via a firewall processor (Figure 2, 211). Coss discloses that a firewall can be

resident in a STB (Column 2, lines 54-57, Column 10, lines 20-24). Coss discloses that the user in communication with the Internet (Column 10, lines 25-27), which would include that the STB interfaces to the Internet or necessarily includes a port. It is necessarily included that the firewall resident in the STB to receive communications from the port. Coss discloses that the firewall is capable of filtering or analyzing information received from the Internet (Figure 4, Column 5, lines 36-50) determining when a source is authorized to communicate with the STB, the firewall thus protecting the STB from unauthorized access (Column 6, lines 26-67, Column 7, lines 1-23). Bru discloses a set top box, and a method comprising: a port coupled to a processor (Figure 1, 116); the processor controlling and processing resource information associated with the STB or CE equipment describing the disk drive and its capacity (Figure 1, 106, 108, Column 1, line 8, Column 2, line 62, Column 3, lines 33-60), the port receiving an operating instruction (Column 4, lines 5-31). Bru discloses that the apparatus with storage can include hard disk drive or solid state memory (Column 1, lines 7-10, Column 2, lines 54-65); and wherein the processor receives and executes the operating instruction when there is a difference between the capacity of the disk drive and the authorized storage for the STB the difference indicating unauthorized modifications to the STB (Column 4, lines 5-44). Microsoft's Computer Dictionary (4<sup>th</sup> edition) defines port as an interface through which data is transferred between a computer and other device, a network or a direct connection to another computer. Bru discloses the operating instruction causes the processor to limit the capacity of the disk drive (Column 4, lines 5-14). Medvinsky discloses the processor receiving an instruction based on

unauthorized modifications and the instruction causing the processor to disable operation of the STB (Page 5, paragraphs 0056, 0058, Page 4, paragraphs 0047-0049).

Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Levin to include initiating communications between a STB or remote unit (Figure 1, 14, Column 3, lines 18-20); a first port (Figure 1, 14) coupled to the first communications network and a database or storage location (Column 7, lines 15-23) and a service provider (Figure 2, Column 6, lines 53-67, Column 7, lines 1-6), database storing configuration information of numerous remote units (Column 3, lines 8-10, Column 7, lines 15-23 and the port of the remote communication unit or STB sending resource information associated with the STB describing memory space and size (Figure 2, Column 6, lines 53-67, Column 7, lines 1-6) and a difference is determined between the capacity of the disk drive and authorized storage for the STB or remote unit defined in a database (Column 7, lines 15-23), the difference indicating unauthorized modifications to the STB (Column 7, lines 28-42) as taught by Feigen in order to verify the integrity of remote units in a communication system (Column 1, lines 45-47) as disclosed by Feigen. Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify the combination to include describing the number of disk drives (Column 3, lines 64-67, Column 4, lines 1-3, Column 5, lines 10-25, 60-67, Column 6, lines 1-10, 53-67, Column 7, lines 1-19) as taught by Gold in order to verify that customers cannot increase disk configuration to help protect the customer from its configuration and to protect the manufacturer's pricing of storage (Column 1, lines 12-20) as disclosed by Gold.

Therefore, it would have been obvious at the time the invention was made to modify the combination to include a firewall determining when a communications protocol is authorized, the firewall thus protecting determining when a source is authorized to communicate with the STB, the firewall thus protecting the STB from unauthorized access (Column 6, lines 26-67, Column 7, lines 1-23. Column 2, lines 54-57, Column 10, lines 20-24) as taught by Coss in order to facilitate parental control of Internet of video access in the home (Column 10, lines 25-27) as disclosed by Coss. Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify the combination to include wherein the processor receives and executes the operating instruction when there is a difference between the capacity of the disk drive and the authorized storage for the STB the difference indicating unauthorized modifications to the STB, (Column 4, lines 5-44) as taught by Bru in order to provide the end user with the capability of upgrade the storage capacity for a fee, however to also prevent unauthorized tampering with the storage capacity (Column 3, lines 61-64, Column 4, lines 42-44) as disclosed by Bru so that there is no loss of revenue from unauthorized upgrades. Therefore, it would have been obvious at the time the invention was made to one of ordinary skill in the art to modify the combination to include the processor receiving an instruction based on unauthorized modifications and the instruction causing the processor to disable operation of the STB (Page 5, paragraphs 0056, 0058, Page 4, paragraphs 0047-0049) as taught by Medvinsky in order to make sure pirates do not hack set top boxes to steal content (Page 1, paragraph 0005) as disclosed by Medvinsky.

Furthermore, the *KSR* Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. No. 04-1350, slip. op. at 12.

Regarding Claims 2 and 19, Levin, Feigen, Gold Coss, Bru and Medvinsky disclose all the limitations of Claims 1 and 18 respectively. Gold discloses describing the number of disk drives or at least two disk drives and capacity of each disk drive (Column 3, lines 64-67, Column 4, lines 1-3, Column 5, lines 10-25, 60-67, Column 6, lines 1-10, 53-67, Column 7, lines 1-19). Bru discloses the operating instruction causes the processor to limit the capacity of the disk drive (Column 4, lines 5-14).

Regarding Claims 3 and 20, Levin, Feigen, Gold, Coss, Bru and Medvinsky disclose all the limitations of Claims 1 and 18 respectively. Gold discloses describing the number of disk drives and capacity of each disk drive (Column 3, lines 64-67, Column 4, lines 1-3, Column 5, lines 10-25, 60-67, Column 6, lines 1-10, 53-67, Column 7, lines 1-19). Levin discloses the operating instruction causes the processor to increase the capacity of a disk drive (Column 3, lines 1-25, 39-64, Figure 2, Figure 3).

Regarding Claim 4, Levin, Feigen, Gold, Coss, Bru and Medvinsky disclose all the limitations of Claim 1. Levin discloses receiving operating instruction (Column 3, lines 1-25, 39-64). Coss discloses that the firewall is capable of filtering or analyzing information received from the Internet (Figure 4, Column 5, lines 36-50).

Regarding Claim 5, Levin, Feigen, Gold, Coss, Bru and Medvinsky disclose all the limitations of Claim 4. Coss disclose the firewall is logically between the first port and other components associated with the STB (Figure 1, 111, 113, 114) as the firewall is resident in the STB to filter received communications (Column 2, lines 54-57, Column 10, lines 20-24, Column 5, lines 36-50).

Regarding Claim 6, Levin, Feigen, Gold, Coss, Bru and Medvinsky disclose all the limitations of Claim 1. Gold discloses that license data or resource information is stored (Column 3, lines 64-67, Column 4, lines 1-3, Column 5, lines 10-25, 60-67, Column 6, lines 1-10, 53-67, Column 7, lines 1-19). Gold discloses a processor capable of determining resources associated with the STB (Column 5, lines 10-25, 60-67, Column 6, lines 1-10, 53-67, Column 7, lines 1-19, Column 10, lines 54-67, Column 11, lines 1-3).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA E. HOSSAIN whose telephone number is (571)272-5943. The examiner can normally be reached on Monday to Friday 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/

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Supervisory Patent Examiner, Art Unit 2623

FEH  
August 6, 2008